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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

ANITA DHALIWAL, an Individual)	Opposition No. 91167207
)	Re: DVD WORLD
Opposer,)	Serial No.: 78495856
)	
v.)	
)	
DVD WORLD PICTURES CORP.)	
)	
Applicant.)	
)	
)	
)	

OPPOSER'S REPLY BRIEF

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I. INTRODUCTION

At the heart of the issue before this Board is whether Applicant should be granted exclusive rights to “DVD WORLD” when there are literally hundreds of others already using the mark and Applicant itself has not made use of the mark in connection with the goods and services that are identified in its application.¹ Registration should be denied because DVD WORLD is merely descriptive of Applicant’s stated goods and services. It is descriptive because DVD WORLD directly and immediately informs consumers that Applicant sells DVDs “across the world.” *See* Papetti Testimony, Exh. 23; *see also, id.* at 34:20-25.

Furthermore, that DVD WORLD does not function as a unique source-identifying mark is evidenced by its widespread use in the marketplace as demonstrated by the fact that there are at least 206 domain names using DVD WORLD in interstate commerce for the retail sale of DVDs. *See* Lahoti Testimony, Exh. 5. In fact, so many others use DVD WORLD that Applicant stated in its own advertising flyer that it had changed its name to “DVD WORLD ONLINE” to avoid being confused with numerous others calling themselves DVD WORLD. *See* Papetti Testimony, Exh. 3; *see also, id.* at 25:8-25.

Not only are there numerous other DVD WORLDS, but Applicant itself has failed to use the mark as indicative of source. Applicant has no brick-and-mortar presence, no advertisement, or even its own designated web site using DVD WORLD. Not surprisingly, Applicant admits that it has not sold a single commercial DVD. *See*

¹ The application at issue is for registration of the standard character wording DVD WORLD for use in connection with “Online Retail store services and distributorships of DVD movies” in Class 35 and “Motion Picture production and Distribution” in Class 41.

Applicant's Br. at 42, 44. The only evidence of Applicant ever having offered any DVDs for sale online is based on "three different high school and middle school productions available for purchase online, at least one of which is available in DVD format." *Id.* at 43. However, these school productions are offered on www.dvdworldhomevideo.com, a web site that does not belong to Applicant. *Id.* (citing Papetti Testimony, Exh. 34). As set forth below, this web site was not even in existence at the time that Applicant filed its application. *Cf.* Papetti Testimony, Exh. 34 and Serial No. 78/495,856.

Though Applicant admits that it has not used the mark to sell a single commercial DVD, it seeks broad trademark rights to prevent others from doing so. This is exactly what it has already done by threatening legal action against Opposer Dhaliwal after she purchased the domain name www.dvdworld.com. See Lahoti Testimony, Exh. 1. If it were granted registration, Applicant would undoubtedly prevent other established online retailers that have long used DVD WORLD from selling DVDs as well.

II. STANDING

Unable to make a case on the merits that it is entitled to registration of DVD WORLD, Applicant instead attacks Opposer Dhaliwal's standing. In a nutshell, Applicant argues that Opposer does not have standing because she does not own the domain name www.dvdworld.com, and thus has no "real interest" in this proceeding.

Opposer Dhaliwal has firm standing to bring this opposition because she has a very "real interest" in the outcome of the proceeding. *Ritchie v. Simpson*, 170 F.3d

1092, 1095 (Fed. Cir. 1999) (requiring “real interest” for standing). Standing is not only vested in her ownership of the domain name www.dvdworld.com, which she had purchased with her own money; it is also vested in the commercial interest she has in partnership with her brother, Dave Lahoti (“Lahoti”), to launch an Internet business to rent or sell DVDs online using that domain name. In fact, it is precisely because such a business would directly compete with Applicant’s business that Applicant threatened to sue Dhaliwal after she purchased www.dvdworld.com. See Lahoti Testimony, Exh. 1. Less than a month after Dhaliwal purchased that domain name, the Applicant issued a cease-and-desist letter, not only falsely alleging trademark infringement and unfair competition, but also demanding that she transfer the domain name to The DVD World Company. *Id.* This Opposition was thus precipitated by Applicant’s threat to “have the www.dvdworld.com domain name transferred to The DVD World Company, and pursue all other remedies and seek recovery of all damages to which DVD World is entitled.” *Id.* In light of Applicant’s explicit threats and demands, Dhaliwal has a “reasonable basis” that she would be damaged by registration. See *Simpson*, 1730 F.3d at 1097-98 (requiring a “reasonable belief” of damage for standing). In short, Opposer Dhaliwal could hardly have a more direct and personal stake in the outcome of this proceeding.

Yet Applicant now argues that Dhaliwal does not have standing because she has not established that she owns www.dvdworld.com. This is not only factually incorrect, it entirely misses the point. Dhaliwal need not have a proprietary interest in the domain name to establish a “real interest” in this proceeding. Though she currently owns a 25% stake in the domain name, Dhaliwal’s standing does not

depend on her ownership stake in www.dvdworld.com. Rather, it is based on her partnership with Lahoti to run and operate any business using that domain name. There is a long-standing partnership that extends beyond the www.dvdworld.com domain name. *See* Dhaliwal Testimony at 26:2-11; *see also*, Lahoti Testimony at 25:1-16. Under this partnership, Dhaliwal would stand to profit from such an enterprise, giving her a commercial interest in the outcome of this proceeding. If Applicant were granted registration for DVD WORLD, it would effectively prevent Dhaliwal from using www.dvdworld.com in partnership with her brother. Therefore, Dhaliwal has standing in this proceeding.

A. Ownership of Domain Name is NOT Necessary to Establish “Real Interest”

The issue here is not whether Opposer Dhaliwal owns www.dvdworld.com, but merely whether it is likely that she would be somehow damaged if a registration for DVD WORLD were granted to the Applicant. As the Trademark Board has stated: “All that is necessary ...is that the ‘person’ bring the opposition establish conditions and circumstances from which damage to it from the opposed mark can be assumed.” *See FBI v. Societe: “M. Bril & Co.”* 172 USPQ 310 (TTAB 1971). In particular, for an opposition grounded on § 2(e), an opposer need only assert an equal right to use the mark. As the Federal Circuit has held, “[a]n opposer in such case need only assert an equal right to use the mark for the goods. Proprietary rights in the opposer are not required.” *See Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 493 (Fed. Cir. 1987). In fact, standing to oppose is *presumed* when the mark sought to be registered is allegedly descriptive of the

goods and the opposer is one who has a sufficient interest using the descriptive term in her business. *See De Walt, Inc. v Magna Power Tool Corp.*, 289 F.2d 656 (CCPA 1961). Though Opposer Dhaliwal need not have proprietary rights in www.dvdworld.com to establish standing, she nonetheless has ownership interests in the domain name.

**1. Dhaliwal Owned the Domain Name at the Time of Filing
this Opposition and Continues to Own 25% of It**

It is not disputed that Dhaliwal purchased www.dvdworld.com with her own money at an Internet domain name auction on or about December 2, 2004 for \$20,010.² Hence, she was the actual owner of the domain at the time of the filing of this Opposition in October 2005.

21 Q. Okay, so how are you related to this
22 proceeding?

23 A. I purchased this domain on my credit
24 card.

25 Q. And by this domain you mean?

1 A. Dvdworld.com.

2 Q. And you purchased it on your credit
3 card?

4 A. Correct.

5 Q. With your funds?

6 MR. TROJAN: With what?

7 BY MR. DONAHEY:

8 Q. You purchased it with your funds?

9 A. Correct.

² In addition to www.dvdworld.com, Dhaliwal has also purchased a number of other domain names at auction, for which she operates successful online businesses. *See Dhaliwal Testimony at 36:22 – 37:8.*

10 Q. And for what purpose did you purchase
11 the domain?

12 A. Well, my brother saw this opportunity.
13 He expressed it to me. He didn't have the
14 funds. He wanted me to get involved with my
15 creative aspect, and I saw it as a great
16 opportunity. I didn't want it to slide, so I
17 purchased it on my credit card.

18 Q. And what was it -- was he going to use
19 the domain name, or were you going to use the
20 domain name?

21 A. I had an idea to -- since I was already
22 selling products on E-bay and had experience in
23 selling products, I wanted to sell, you know,
24 DVD's on-line and bring about a bunch of DVD's
25 and offer it in the world, and create a great

See Testimony of Anita Dhaliwal ("Dhaliwal Testimony") at 28:21 – 30:9; *see also*,
Lahoti Testimony at 6:25 – 7:9 and 29:16 – 30:4

Applicant argues, however, "Opposer Dhaliwal did not purchase the domain name, but merely loaned her brother Dave Lahoti funds so he could purchase the dvvdworld.com domain name." See Applicant's Br. at 19. This is predicated on the false premise that ownership of the domain name is based on who paid for it. Dhaliwal testified that she jointly owned the domain in partnership with Lahoti based on their shared involvement in running the business:

1 Q. Since he repaid you -- was your
2 involvement -- characterize your involvement as a
3 loan?

4 A. My involvement was to be a creative
5 director in the company and come up with ideas
6 and handle all the -- since I have experience
7 with E-bay and selling products, I was going to
8 apply that experience on DVD World.

23 Did you have any agreement with your
24 brother Dave, written or otherwise, regarding the
25 ownership of dvdworld.com?

1 A. Yes, we were going to have -- be equal
2 partners, and I was going to do the creative
3 direction and website design, concept and all of
4 that, and he was going to take care of all the
5 technical part of the business.

6 Q. Was this agreement written?

7 A. No, verbal.

See Dhaliwal Testimony at 32:1 - 33:7. Dhaliwal further explained that the partnership with her brother continued after he paid her for the domain name:

9 Q. So after Dave repaid you, who owned the
10 dvdworld.com domain name?

11 A. We were in partnership in the sense, so
12 I and he's my technical guy, so I've always --
13 what do you mean who owned it?

14 Q. Well, it's property. Who is the
15 property of the dvdworld.com domain name?

23 | Q. Who owned the dvdworld.com domain name?
24 | A. I owned it when I purchased it. After
25 | that I gave it to Dave to take care of so.

1 | Q. Did the two of you own it in
2 | partnership?

3 | A. I took it as -- I'm a partner as the
4 | creative director.

5 | Q. And so you didn't own it all by
6 | yourself?

7 | A. No.

8 | Q. And Dave didn't own it all by himself?

9 | A. No.

16 | Q. But you both owned it in partnership
17 | with one another?

18 | A. Correct.

See Dhaliwal Testimony at 37:9 - 38:18. This is corroborated by Lahoti:

17 | Q Did your sister ever own the dvdworld.com
18 | domain name?

19 | A Yes, we both invested in the purchase of that
20 | domain.

21 | Q Were you partners?

22 | A Yes.

23 | Q Was there ever any kind of business entity
24 | regarding this partnership, either a formal partnership
25 | or an LLC or a corporation?

1 A She's my sister, so it's -- there was no
2 formal -- nothing formal.

See Lahoti Testimony at 24:17 - 25:2. For Applicant to argue that Dhaliwal did not own the domain because her purchase of it was merely a loan to Lahoti is inconsistent with the testimony of record. Indeed, if Dhaliwal merely loaned the funds to Lahoti and had no ownership interest in the domain name (as Applicant asserts), she would not have been able to later transfer it to Lahoti:

3 Q. Did you ever sell it to Virtual Point or
4 give it to Virtual Point?
5 A. Yeah, I gave it to him.
6 Q. And when did this take place?
7 A. I don't recall exactly.
8 Q. Was it after June of 2006?
9 A. Definitely after, but I don't recall
10 exactly when.

9 Q. But you know at some point you were the
10 registered owner?
11 A. Yes.
12 Q. And at some point after June 2006 that
13 changed?
14 A. Yes.

See Dhaliwal Testimony at 73:3-10, 75:9-14. Since Dhaliwal did not transfer the domain to Lahoti until after June 2006, she was the actual owner of the domain at the time of the filing of this Opposition in October 2005. Therefore, Applicant's

argument that Opposer Dhaliwal lacks standing because she did not own www.dvdworld.com is factually incorrect.³

Moreover, in January 2010 Virtual Point transferred 25% of the interest in www.dvdworld.com back to Dhaliwal. See Dhaliwal Testimony, Exh H. Today Opposer Dhaliwal owns 25% of the domain name. See Dhaliwal Testimony at 71:23-25; 72:13-22.

2. Opposer Dhaliwal's "Real Interest" is Based on Her Partnership with Lahoti to Use the Domain Name

Although www.dvdworld.com changed hands between Dhaliwal and her brother after this Opposition was brought in October 2005, the underlying partnership did not change.

24 | Q. I'm sorry, Anita, if you would explain
25 | the difference, if any, between you being the

1 | only owner and you and Dave owning it, this part
2 | of the business.

3 | A. The domain dvdworld.com I owned it. The
4 | business that we were going to pursue, we were
5 | doing it as a partner.

³ In support of its contention that Opposer Dhaliwal is "not the rightful owner of the dvdworld.com domain," Applicant makes much of Dhaliwal's "lack of involvement with this Opposition," arguing that this shows that Lahoti is the "true owner" of the domain. See Applicant's Br. at 20-21. The argument, based on little more than insinuations, ignores Dhaliwal's testimony that, under the partnership with her brother, Lahoti handled the technical operations of the business and legal matters such as this proceeding. See Dhaliwal Testimony at 39:1-6 and 72:13-22. In any case, whether Dhaliwal actively participates in the proceeding is not the test for standing, which requires only that she demonstrate a "real interest" in its outcome.

See Dhaliwal Testimony at 59:24 – 60:16. The partnership continued even after Lahoti took ownership of the domain and transferred it to his company, Virtual Point, in 2007.

4	Q. We talked about the ownership of
5	dvdworld.com as of June 2006. Did you continue
6	to own dvdworld.com after June 2006?
7	A. Like I said it was a partnership so.
8	Q. Does that arrangement still exist today?
9	A. Yes.

See Dhaliwal Testimony at 66:4-9.

The argument that Opposer Dhaliwal lacks standing because she did not own www.dvdworld.com is a red-herring because it is falsely premised on the notion that standing must be rooted in ownership of the domain www.dvdworld.com. However, Opposer Dhaliwal's "real interest" is not merely vested in her ownership of the domain name, it is also vested in the partnership with her brother to use that domain name. Their planned enterprise to build an online DVD business based on www.dvdworld.com gives Dhaliwal a direct commercial interest in this proceeding. Therefore, Dhaliwal has proper standing in this Opposition.

B. Opposer Dhaliwal Need NOT Demonstrate that She is a Present Competitor to Establish Standing

Applicant further argues, "[e]ven if Opposer Dhaliwal is and was the owner of the dvdworld.com domain name, Opposer Dhaliwal has failed to document any plans or steps taken regarding of DVD WORLD or dvdworld.com or that she is a competitor of Applicant in either the sale of DVD's or the production of motion pictures." See Applicant's Br. at 22. It is not necessary that Opposer Dhaliwal

actually use the mark at issue in order to challenge on the basis of descriptiveness or genericness. All that is necessary is that she be in a position to have a right to use of that term. *See Meehanite Metal Corp. v. International Nickel Co., Inc.*, 262 F.2d 806, 808, 120 USPQ 293 (1959) (noting “it is not necessary that opposer make a showing of actual use of the mark to establish that it would probably be damaged by the registration.”). Moreover, a competitor presumptively has standing. *See De Walt, supra*.

The fact that Opposer Dhaliwal spent more than \$20,000 to purchase the domain name clearly demonstrates the seriousness of her plans to launch an online DVD business. *See* Dhaliwal Testimony at 28:21 – 30:9; *see also*, Lahoti Testimony at 6:25 – 7:9. It was the very prospect of this unwelcomed competition from Opposer that caused Applicant to issue the cease-and-desist letter to Dhaliwal. *See* Lahoti Testimony, Exh. 1. Thus, Applicant’s argument that Opposer Dhaliwal has not demonstrated that she is a competitor of Applicant is rather peculiar in light of Applicant’s demand that she not compete with it. And its argument that Dhaliwal has not done enough with www.dvdworld.com to warrant standing is also rather peculiar since it was Applicant’s threat of legal action that prevented Dhaliwal and her brother from making use of that domain name.⁴ *See* Lahoti Testimony at 41:20 – 42:6; 44:1-7.

⁴ More peculiar still, Applicant contends that “[e]ven if Opposer were able to demonstrate that the pending application should be denied to Applicant, Opposer’s alleged harms and injuries would not be resolved as Applicant would still own its prior registration for related services...” *See* Applicant’s Br. at 27. Applicant’s prior registration is for a composite mark comprising a globe design and the words “DVD WORLD.” Whether Applicant can assert the registered composite mark to prevent

II. DESCRIPTIVENESS

A. DVD WORLD is Descriptive as a Matter of Law Because It Informs Consumers that Applicant Sells DVDs “Across the World”

As Applicant itself acknowledged, “[w]hether a given mark is suggestive or merely descriptive depends on whether the mark immediately conveys...knowledge of the ingredients, qualities, or characteristics of the goods...with which it is used, or whether imagination, thought, or perception is required to reach a conclusion on the nature of the goods.” See Applicant’s Br. at 28 (citing *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987) (internal quotations omitted)). Though Applicant dutifully recites the test, it conspicuously fails to apply a word of it. If Applicant contends that DVD WORLD is not descriptive, it must explain how DVD WORLD does *not* convey knowledge of the “ingredients, qualities, or characteristics” of Applicant’s online services for DVDs. Alternatively, if Applicant contends that DVD WORLD is suggestive, it must explain what “imagination, thought, or perception” is required to reach a conclusion on the nature of Applicant’s DVDs.

To paraphrase the Board in *In re Tower Tech Inc.*, the question here is not whether someone presented with only the mark DVD WORLD could guess what the goods or services are. Rather, the question is whether someone who knows that the goods and services are for online retail store services and distributorships of DVD movies (Class 35) and motion picture production and distribution (Class 41) will understand DVD WORLD to convey information about such services and goods. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1317 (TTAB 2002). Put differently, “[w]hether

Dhaliwal from using www.dvdworld.com is irrelevant to the question of Opposer’s standing in this action.

consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Here, the word “WORLD” merely indicates that Applicant sells DVDs “across the world.” *See* Papetti Testimony, Exh. 23; *see also, id.* at 34:20-25. As previously noted, the Applicant stated that it “sells it’s [sic] products to everyone in the world...There is not one country DVD World does not ship to or sell to...DVD World sells across the world.” *Id.* In particular, Applicant’s “websites clearly show that we ship everywhere.” *Id.* Therefore, DVD WORLD directly and immediately inform consumers of at least one significant feature of the goods and services set forth in the application, namely, that Applicant’s DVDs are available all over the world. Glaringly, Applicant does not dispute any of this in its brief.

Instead, Applicant argues that “WORLD” is “suggestive of a service or store that features a wide breadth of information or materials.” *See* Applicant’s Br. at 31. If WORLD is broadly understood to mean a “distinctive class of persons or their sphere of interests,” as Applicant urges, then online retail sales and distribution of DVDs, as well as motion picture production, would certainly fall within that broad “sphere of interests.” It is precisely because “WORLD” can be broadly understood to describe a “service or store that features a wide breadth of information or materials” that consumers can—without “imagination, thought, or perception”—immediately recognize that DVD WORLD describes Applicant’s digital video goods and services.

B. Applicant Has NO Exclusive Rights to DVD WORLD Because Many Other Third-Parties Already Use DVD WORLD in Commerce

That DVD WORLD does not function as a mark that is indicative of source is evidenced by its widespread use by others. *See, e.g., Data National Corp. v. BellSouth Corp.*, 18 USPQ2d 1862, 1865 (TTAB 1991). There are at least 206 other domain names using DVD WORLD in interstate commerce for the retail sale of DVDs, including, for example, *sonydvdworld.com*, *thedvdworld.com*, *musicdvdworld.com*, *mydvdworld.com*, *dvdworldusa.com*, etc. *See* Lahoti Testimony, Exh. 5. Lahoti testified that he found “at least half a dozen” companies that sell DVDs online using domain names containing “dvdworld”. *See* Lahoti Testimony at 8:3 – 9:11.

Applicant argues that the “Domain List is unreliable and unpersuasive evidence of the alleged descriptiveness of Applicant’s DVD WORLD mark” because “[t]he mere existence of the domain names on Opposer’s Domain List does not demonstrate that they are used in connection with the relevant services, that they are used at all, or that they are used in the United States.” *See* Applicant’s Br. at 29. The objection is puzzling, since Applicant stated in its own advertising flyer that it had changed its name to “DVD WORLD ONLINE” to avoid being confused with numerous others calling themselves DVD WORLD:

The Following Year Would Bring A Name Change To “DVD WORLD”, It Would Now Be Called “DVD WORLD ONLINE”. This Was Done Due To the Numerous Amounts of International Stores That Were Saying They Were ‘DVD WORLD’ But Weren’t.

See Papetti Testimony, Exh. 3; *see also, id.* at 25:8-25. Applicant offers no explanation of this in its brief. It can hardly be said that the domain list of 206

domain names is “unreliable and unpersuasive” when Applicant itself publicly advertised its own change of name due to numerous other businesses calling themselves DVD WORLD.⁵

C. Third-Party Registrations Are Not Probative

In an effort to demonstrate that DVD WORLD is suggestive, Applicant points to third-party registrations that include the word “WORLD,” citing some 45 such registrations. *See* Applicant’s Br. at 32-39. It is well-settled that third-party registrations are not determinative of descriptiveness. *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001); *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). Each case must be decided on its own merits. *Id.* Of course, this Board is not bound by previous decisions of examining attorneys to register other marks which may or may not be descriptive of the goods or services with which they are used. *In re Pennzoil Products, Co.*, 20 USPQ2d 1753 (TTAB 1991).

Upon closer inspection, moreover, in each one of the third-party registrations that Applicant cites, there is some incongruous or nondescriptive meaning that requires imagination, thought, or perception to reach a conclusion on the nature of the goods. To take but one example, “BIKINI WORLD” does not describe “provision

⁵ Applicant objects to the advertising flyer that shows the use of “DVD WORLD” by a third-party in Corvallis, Oregon. *See* Lahoti Testimony, Exh. 65. The Corvallis advertisement is for a “family owned and operated” store calling itself DVD WORLD that opened “in November 2002 in the Bed, Bath & Beyond Center on 9th Street next to Starbucks.” *Id.* Applicant moves to strike the Corvallis advertisement because it was not produced during discovery. *See* Applicant’s Br. at 10. Since the disclosure of the Corvallis advertisement in November 2009, Applicant had many months to conduct any necessary follow-up discovery, but failed to ask for further discovery or otherwise to take any step to investigate the issue. It is plainly disingenuous of Applicant to now argue that it did not have sufficient opportunity to conduct discovery.

of non-downloadable on-going audio visual film...” See Applicant’s Br. at 32. In this and the other registrations, the goods or services are tangential to the meaning of the words in the mark. For example, “GOALKEEPER WORD” is for “[p]re-recorded CDs and DVDs featuring instructional soccer goaltending performance development programs.” *Id.* at 33. And “Brides World” is for “[a]rranging and conducting trade show exhibitions in the field of weddings...” *Id.* Whereas in this case, DVD WORLD describes the core nature of Applicant’s goods and services, which is the making and selling of DVDs.

In addition to third-party registrations, Applicant also relies on its prior registration for a composite mark (comprising a globe design and the words “DVD WORLD”) as “further evidence that ‘WORLD’ is not descriptive as applied to Applicant’s services.” See Applicant’s Br. at 40. That Applicant obtained registration for such a composite mark is irrelevant to the issue of whether the words themselves are registerable, and Applicant has provided neither law nor reason to explain why its prior registration is relevant.⁶

IV. Applicant Failed to Use DVD WORLD as Trademark

Registration should also be denied because Applicant has failed to use DVD WORLD as a trademark for the goods and services identified in its application.

⁶ Applicant also throws in the argument that “Opposer has not demonstrated that the mark has not acquired distinctiveness.” See Applicant’s Br. at 40. Opposer has met her prima facie burden of showing that DVD WORLD has not acquired distinctiveness by presenting evidence of widespread use of the mark by others. Moreover, Opposer presented evidence that Applicant failed to use the mark, thus it could not have acquired distinctiveness. The “ultimate burden of persuasion” is on the applicant. See *Duramax Marine, LLC v. R.W. Fernstrum*, 80 U.S.P.Q.2d 1780, 2006 WL 2263820 (TTAB 2006).

Applicant—DVD World Picture Corp.—does not actually rent, sell, or otherwise distribute DVDs.

15 Q Has the DVD World Pictures Corporation
16 website ever sold any DVD's?
17 A The actual site? No. No, it has not.

See Papetti Testimony at 53:15-17. There is not even a designated web site for DVD World Pictures Corporation. As set forth in Opposer's opening brief, Applicant's claim of online retail sales of DVDs is mainly based on www.dvdworldonline.com, a domain name shared by a number of other entities. See Papetti Testimony at 21:15 - 22:25. But none of the sales that occur via www.dvdworldonline.com are actually sold by Applicant.

8 Q Do any sales of DVD's that are sold on
9 the website that I can access through
10 DVDWorldOnline.Com -- are any of those DVD sales
11 sold through DVD World Pictures Corporation: yes
12 or no?
13 A The DVD's are available through
14 DVDWorldOnline.Com or HDDVDWorld.Com are
15 commercially available titles. They are not created
16 by DVD World Pictures.
17 Q And none of the sales that occur on
18 DVDWorldOnline.Com or HDDVDWorld.Com go through DVD
19 World Pictures Corporation; correct?
20 A That's correct.

Id. at 33:20 - 35:20.

In its brief, Applicant now admits that it does not sell commercial DVDs (*i.e.* titles that are not made by Applicant). *See* Applicant's Br. at 42, 44. All "authorized retail sale of commercial titles on DVDS [are] through Applicant's related entities." *Id.* at 42; *see also*, Papetti Testimony at 19:6-8. To be clear, then, the online retail store services and distributorships that Applicant identifies in Class 35 are not for commercial titles. So the thousands of commercial DVDs that have been sold, according to Papetti's testimony, are not attributable to the Applicant. *See* Papetti's Testimony at 30:1 – 32:5.

A. Applicant's DVD Sales of Its Own Motion Picture Productions Do Not Constitute Trademark Use

If Applicant does not sell commercial DVDs, then what is the basis for its claim of online retail store services and distributorships of DVD movies in Class 35? Applicant asserts that it "offers retail DVD sales of Applicant's own motion picture production." *See* Applicant's Br. at 42. Specifically, Applicant cites to only this: "three different high school and middle school productions available for purchase online, at least one of which is available in DVD format." *Id.* at 43. It is by no means clear that even this meager offering is made available by Applicant through its own website. The only evidence that Applicant points to is "an image of the web page at www.dvdworldhomevideo.com where Applicant offers DVDs of its own productions for sale to the public...this web page uses the DVD WORLD *design* mark in the top left, the center title ("DVD World Home Video"), and in the welcome message – "Welcome to DVD World Home Video." *Id.* (emphasis added) This web page does not show that DVD WORLD is used as a trademark to identify the Applicant.

Notably, the www.dvdworldhomevideo.com on which Applicant asserts that it “offers retail DVD sales of Applicant’s own motion picture production” **does not appear to have existed at the time that Applicant filed its application.** Applicant filed the instant application on October 6, 2004. However, the www.dvdworldhomevideo.com web page bears a copyright date of 2005-2006. *See* Papetti Testimony, Exhibit 34. There is no evidence to show that this web page was in existence at the time of the filing of the application.

Moreover, the web page belongs to DVD World Home Video. The domain name is www.dvdworldhomevideo.com. As Applicant points out, its welcome message is: “Welcome to DVD World Home Video.” *See* Applicant’s Br. at 43. There is nothing on the web page to show that DVD WORLD is used to identify the Applicant. Consumers who encounter the DVD World Home Video web page at www.dvdworldhomevideo.com would have no way of knowing that it is Applicant, DVD World Picture Corp., that offers those goods and services.

B. DVD Sales Through Purportedly Related Entities Do NOT Inure to Applicant’s Benefit

To get around the fact that it cannot make a showing that it has ever sold a single DVD online, Applicant argues that it has “authorized other related entities owned by Applicant’s principal Edwin Papetti to sell third-party commercial DVDs under the DVD WORLD mark. *See* Applicant’s Br. at 45. This is based on the “related company” doctrine, which Applicant recites as follows:

Trademark Act § 5, in pertinent part, provides that “[w]here a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration,

provided such mark is not used in such manner as to deceive the public. Trademark Act § 45 in turn defines “related company” as meaning “any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of goods or services on or in connection with which the mark is used.”

Id. Applicant contends that, because “Applicant DVD World Pictures Corp[.] is owned by [Mr. Papetti] under his sole proprietorship The DVD World Company,” “Applicant itself and through related companies has clearly used the DVD WORLD mark on all of the services identified in the application.” *Id.* at 45-46. Applicant’s reliance on the “related company” doctrine is misplaced.

The “related company” doctrine requires a showing of a substantial relationship between Applicant and Papetti’s other purported companies. The Applicant is DVD World Pictures Corp., a legal entity incorporated in the State of New York. *See* Applicant’s First Notice of Reliance, Exh. 5. None of Papetti’s other purported companies—The DVD World Company, HD DVD World, DVD Destination, or DVD World Home Video—are cognizable legal entities. That is, they are not companies in any legally determinative sense. They are no more than fictitious business names that Papetti created; there is no evidence to show that Papetti even registered these names as business names (*i.e.* “doing business as” names). Since these entities are as vaporous as air, they cannot be “related” to Applicant under Trademark Act § 5.

Furthermore, the issue here is not whether these fictitious entities—*i.e.* The DVD World Company, HD DVD World, DVD Destination, or DVD World Home Video—are related to Papetti as an individual. Rather, the issue is whether these fictitious entities are related to DVD World Pictures Corporation. **It is DVD World**

Pictures Corp., not Papetti as an individual, that is the applicant for registration of the mark. There is not a shred of evidence to show that these fictitious entities are related to the Applicant.

In order to establish that The DVD World Company, HD DVD World, DVD Destination, or DVD World Home Video are related to DVD World Pictures Corp., Applicant—*i.e.* the company itself—must demonstrate that it exercised control over “the nature and quality of goods or services on or in connection with which the mark is used.” *See* Trademark Act § 45. Though Papetti is the controlling hand behind these fictitious entities, there is no evidence that DVD World Pictures Corp., in its distinct legal capacity, controlled how the mark was used by The DVD World Company, HD DVD World, DVD Destination, or DVD World Home Video. Nor is there evidence that Papetti acted in his capacity as a principal officer of DVD World Pictures Corp. in this respect. Papetti’s use of various fictitious business names do not constitute Applicant’s control over “the nature and quality of goods or services on or in connection with which the mark is used” by these fictitious entities.

In *Great Seats, Ltd. V. Great Seats, Inc.*, 84 USPQ.2d 1235, 2007 WL 1740870 (TTAB 2007), the Board addressed a case that is on point with this case. In *Great Seats*, the petitioner filed a petition for cancellation, alleging that the application from which the registration matured was void because it was not filed by the owner of the mark. *See* 2007 WL 1740870 *1. The respondent in that case was “the ‘660 corporation.” *Id.* at *3. The principal of the ‘660 corporation was “Danny Matta.” *Id.* at *2. Matta had earlier formed “the ‘410 corporation.” *Id.* at *3. The ‘410 corporation used the mark “GREAT SEATS.” *Id.* But it was the ‘660 corporation that

later filed the application. *Id.* at *4. The issue was whether the '660 corporation, which filed the application, was the owner of the mark as of the application filing date. *Id.* at *5.

There, as here, the respondent invoked the “related company” provision of the Trademark Act, §§ 5 and 45. The respondent contended that, although the '410 corporation and the '610 corporation were two separate entities, they were related companies such that the '410 corporation's use of the mark inured to the benefit of the '610 corporation. *Id.* at *9. In rejecting the argument, the Board observed:

The mere fact that Mr. Matta may have controlled both corporations does not suffice to establish that the applicant '660 corporation, itself, controlled the '410 corporation's use of the mark. On this record, we find that any such control by Mr. Matta over the '410 corporation's use of the mark was exercised by Mr. Matta either in his capacity as principal executive officer of the '410 corporation itself, or in his individual capacity as owner of both corporations. There is no evidence that Mr. Matta's control over the '410 corporation was exercised in his capacity as an officer of the applicant '660 corporation.

Id. at *10.

Similarly, here, there is no evidence that the Applicant controlled the goods and services rendered under the “DVD WORLD” as used by the other entities. In particular, there is no evidence showing that Papetti operated in his capacity as the principal officer of DVD World Pictures Corp. to exercise control over these other entities. Therefore, the fictitious business names under which Papetti operated do not constitute “related companies” such that their purported goods and services would inure to the benefit of the Applicant.

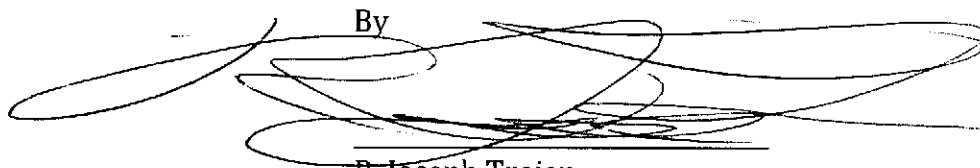
V. CONCLUSION

For the foregoing reasons and based on the evidence of record, the Board should sustain this opposition and refuse registration of the mark DVD WORLD.

Respectfully Submitted,

TROJAN LAW OFFICES

By

A large, stylized handwritten signature in black ink, appearing to read 'R. Joseph Trojan', is written over a horizontal line.

R. Joseph Trojan

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CERTIFICATE OF SERVICE

This is to certify that copies of the following documents in connection with the Opposition No. 91167207 re: DVD WORLD, Serial No. 78495856, were served by mailing a copy thereof by first class mail, postage prepaid, to the following persons:

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OPPOSER'S REPLY BRIEF

Faxed and mailed this 26th of August, 2010.

Respectfully Submitted,

TROJAN LAW OFFICES

By

Date: August 26, 2010

/R. Joseph Trojan/

R. Joseph Trojan
Attorney for Opposer,
ANITA DHALIWAL